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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,700	11/20/2003	Daniel R. Barelmann	0EKM-107845	1352

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EXAMINER
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BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/719,700	BARELMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen L. Blau	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas in view of 0 433 843 and 11-206936.

Haas discloses a hollow sports device (Fig. 1) being made of a plurality of layers of prepreg (Abstract, [0029]), a hollow member having a painted layer of a first color by a shaft being pulled through a reservoir of paint [0047] and graphics being applied in the form of a heat transfer decal [0048]. Haas does disclose if the paint layer is applied along a majority of a length of a shaft but clearly an artisan skilled in the art of applying a paint on a shaft would have selected a suitable amount of the shaft to paint in which along a majority of a length of a shaft is included. In addition, Haas does not disclose where the decal is applied but clearly an artisan skilled in the art of applying decals to a painted shaft would have selected a suitable location of the decal in which affixing a decal to the paint layer is included.

Haas lacks a tubular golf club shaft having a butt end, a tip end, a longitudinal length, a tapered portion, a paint layer along the majority of its length, a decal affixed to

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the paint layer, a decal having a length of between about 5 % to about 90 % the length of the shaft, a decal having a width that varies along at least a portion of the decal length, a first width along a first end of a decal toward the butt end of the shaft, a second width along a second lateral end toward a tip end, a first width being greater than a second width, first and second widths being less than about 5 % greater than the tubular member's outer circumference at the corresponding location, a decal having second, third, fourth and fifth colors as defined by the claims, a lateral band at a tubular location, and a decal having a length less than  $\frac{1}{4}$  the length of the of the tubular member.

It would have been obvious to modify the shaft of Haas to have the painted layer along the majority of a length of a shaft of a sporting device in order to make the substantially length of a shaft a color which is pleasing to an athlete. It would have been obvious to modify the shaft of Haas to have a decal affixed to the paint layer in order to simplify the manufacturing process of a shaft of a sporting device by painting the entire shaft and by not having to place a decal only where the shaft is not painted.

0 433 843 discloses a tubular golf club shaft (Fig. 7) having a butt end, a tip end, a longitudinal length, a tapered portion (Fig. 11), a decorative layer over the entire surface of a shaft (DERWENT, Equivalent Abstract), a decorative layer having variable width profile, a first width along a first end of a decorative layer toward the butt end of the shaft, a second width along a second lateral end toward a tip end, a first width being greater than a second width (Fig. 3, DERWENT, Equivalent Abstract), and first and second widths being less than about 5 % greater than the tubular member's outer

circumference at the corresponding location (Fig. 7). In view of the reference of 0 433 843 it would have been obvious to modify the sporting device of Haas to be a tubular golf club having a butt end, a tip end, a longitudinal length, and a tapered portion in order to utilize the benefits of the invention of Haas for a golf club. In view of the reference of 0 433 843 it would have been obvious to modify the golf club of Haas to have a decal having a width that varies along at least a portion of the decal length, a first width along a first end of a decal toward the butt end of the shaft, a second width along a second lateral end toward a tip end, a first width being greater than a second width, first and second widths being less than about 5 % greater than the tubular member's outer circumference at the corresponding location in order to fit a decal along the profile of a tapered shaft without wasting decal material and in order to have graphics around the entire circumference of the shaft.

11-206936 discloses placing a decal on a shaft having multiple colors (DERWENT, Abstract, Solution) and placing a decal over a portion of the shaft (Fig. 1). 11-206936 does not disclose the exact % of the shaft a decal is located but clearly an artisan skilled in the art would have selected a suitable portion of a shaft to place a decal in which a decal having a length of between about 5 % to about 90 % the length of the shaft and a decal having a length less than  $\frac{1}{4}$  the length of the of the tubular member are included. In view of 11-206936 843 it would have been obvious to modify the golf club of Haas to have a decal having a length of between about 5 % to about 90 % the length of the shaft and a decal having a length less than  $\frac{1}{4}$  the length of the of the tubular member in order to not monopolize the surface area of a shaft with a decal so a

player is able to enjoy the color of the painted layer. In view of 11-206936 843 it would have been obvious to modify the golf club of Haas to have a first, second, third, fourth and fifth colors and a band as defined by the claims as a design choice for using printed matter to create a painted shaft with a decal, logo or graphics which is decorative and visually pleasing to a golfer.

### ***Response to Arguments***

3. The argument that it is improper to use the reference of EPO '843 since this reference does not disclose a heat transfer decal is disagreed with. Haas clearly discloses a heat transfer decal. EPO '843 was being used to show that it is known to place a decoration layer which a decal is on a shaft with the dimensions as claimed (varying width, width being greater than the tubular circumference, etc...). And in the broadest since a fabric with resin on an outer layer to produce a decorative color is a heat transfer decal in that the layer must be cured for the completion of the transfer of decorative layer (decal). The argument that it is improper to use the reference of EPO '843 since it does not disclose a painted layer and a decal with colors as claimed is disagreed with. EPO '843 was not used to show a decal affixed to a painted layer. Haas was used to show decals affixed to a shaft which already has a painted layer. The types of colors in decals are considered as printed matter and it is obvious to selected different designs and colors as a matter of choice and as such printed matter is not patentable.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 13 November 2005



**STEPHEN BLAU**  
**PRIMARY EXAMINER**